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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/043,695

01/10/2002

Rotem Cooper

010110

7705

23696 7590 06/24/2010  
QUALCOMM INCORPORATED  
5775 MOREHOUSE DR.  
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EXAMINER

IQBAL, KHAWAR

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

06/24/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,695	<b>Applicant(s)</b> COOPER, ROTEM	
	<b>Examiner</b> KHAWAR IQBAL	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4-16-2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 5-21 is/are allowed.
- 6) ☒ Claim(s) 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Since the specification fails to define the limitation of "processor readable media" as recited in claims 22-24 such that one skill in the art would recognize processor readable media covers transitory media, i.e., signals, which is non-statutory.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added claims 22-24, in accordance with amendment filed 03/27/06, contain limitation "A processor readable media", which was not described in original specification and/or original claims. Thus claims 22-24 contains in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "said processor" in page 9, line 2. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

6. Claims 1-3, 5-21 are allowed.

7. Examiner's Statement of Reasons for Allowance:

The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 1-3, 5-21, the closest prior arts, Mazzara (20030087642) teaches in a mobile station including a preferred roaming list, a method for an efficient selection system for registration/acquisition of wireless communications systems that avoids time consuming acquisition of a signal that takes up to about 20 seconds, comprising: maintaining a list of unusable wireless communications systems, each entry of a wireless communication system in the list of unusable wireless communications systems including a system identifier and corresponding avoidance criterion for not using the wireless communication system, wherein at least one of said

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unusable wireless communications systems is included on the preferred roaming list; selecting a wireless communications system from the preferred roaming list of wireless communication system in accordance with a predetermined system acquisition sequence, each entry of a wireless communication system in the preferred roaming list including system identifier; determining whether the selected wireless communication system from the preferred roaming list is a useable wireless communication system or an unusable wireless communication system; attempting to acquire and register with the selected wireless communications system when the selected wireless communication system is determined to be a useable wireless communication system; repeating the step of selecting when the selected communication system is determined to be an unusable wireless communication system; wherein the selected wireless communications system is determined to be an unusable wireless communication system when a system identifier for the selected wireless communication matches a system identifier in the list of unusable wireless communications systems and when avoidance criterion corresponding to the system identifier in the list of unusable wireless communication system is satisfied. Bamburak et al (6195532) teaches repeating the step of selecting, before attempting to acquire and register with the selected wireless communications system. Bamburak et al further teaches that provider location method involves storing a frequency band search schedule which has several bands in a predetermined order. Information is stored on several categories of service provider. The frequency bands are examined until a frequency band with an acceptable service provider is located by examining the bands in the order specified. A category of service

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provider is identified for the acceptable service provider. Information such as service operator codes broadcast on a frequency band control channel is compared with the stored information on the service provider categories. Narasimha et al (20020187804) teaches wireless system tries to acquire CDMA system for a particular period of wait time for a wireless terminal 130. During this time period, the system does not use any wireless communication system the wait time starts from the current time. Thus, it is clear that the claimed "avoidance criterion" is equal to the current time the terminal's system makes an attempt plus the waiting. Claims 1-3, 5-21 are allowable over the prior art of record since the cited references taken individually or in combination and Remarks (10-12-09) fails to teach maintaining a list of unusable wireless communications systems, each entry of a wireless communications system in the list of unusable wireless communications systems including a system identifier and corresponding avoidance criterion that is equal to a current time plus an avoidance duration time from a look-up table that includes an entry for each of a plurality of communications failures and corresponding avoidance durations for not using the wireless communications system, wherein at least one of said unusable wireless communications systems is included on the preferred roaming list.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should clearly be labeled "Comments on Statement of Reasons for Allowance."

***Response to Amendment***

8. The amendment filed 04-16-2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Newly added claims 22-24, accordance with amendment filed 03/27/06, contain limitation "A processor readable media", which was not described in original specification and/or original claims. Thus claims 22-24 contains in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

9. Applicant's arguments filed 04-16-2010 have been fully considered but they are not persuasive. Regarding claims 22-24 are rejection under 101, Applicant's arguments on page 11. Examiner respectfully disagrees with this argument.

Independent claim 22 recites, "A processor readable media for storing instructions", which was not defined in the specification.

Thus, independent claim 22 includes both the claims subject matter recited in non transiting medium and transiting medium, which are non statutory.

For the foregoing reasons, independent claim 22 does not recite statutory subject matter under 35 U.S.C 101.

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10. Regarding claims 22-24 are rejection under 35 U.S.C. 112, first paragraph, remarks on pages 11-12. Examiner respectfully disagrees with this argument. Newly added claims 22-24, in accordance with amendment filed 03/27/06, contain limitation "A processor readable media", which was not described in original specification and/or original claims. Thus claims 22-24 contains in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In addition, after careful review of the cited paragraph 0009, examiner can not find any support of the claimed limitation "a processor readable media for storing instructions". The cited paragraph states that the processing circuitry is stored in the memory. However, this processing circuitry can not be the claimed "instructions".

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is (571)272-7909. The examiner can normally be reached on 9 am to 6.30 pm Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGE ENG can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/K. I./  
Examiner, Art Unit 2617